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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 0828.65333
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p>Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. <u>47,954</u> Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p> Signature</p> <p>Josh C. Snider Typed or printed name</p> <p>(312) 360-0080 Telephone number</p> <p>May 14, 2007 Date</p>
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>		

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tada et al.
Serial No.: 09/813,553
Conf. No.: 3668
Filed: March 21, 2001
For: DATA LINKING SYSTEM
Art Unit: 3691
Examiner: Akintola, Olabode

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May 14, 2007

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Date

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Attorney for Applicant(s)

Appr. February 20, 1998

Registration No. 47,954
Attorney for Applicant(s)

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE AND REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the Notice of Appeal filed concurrently herewith, Applicants respectfully request a Pre-Appeal Brief Conference and Review of the outstanding rejections in the present case, and also the withdrawal of these rejections. The reasons for this Request are as follows:

REMARKS

The outstanding Section 103(a) rejection of claim 1 of the present invention based on a combination of Wolff (U.S. 6,009,427) and Ikeda (U.S. 5,822,785) should be withdrawn because the asserted *prima facie* case of obviousness is deficient on its face under both of Sections 2143.03 and 2143.01 of the MPEP. The proposed combination fails to teach or suggest every feature and limitation of the present invention, and the rejection fails to cite to any affirmative teaching or suggestion from either reference that indicates the actual desirability of making the proposed combination.

The outstanding rejection is deficient under Section 2143.03 because neither of the cited references teaches or suggests that each of a transmitter-side and the receiver-side storage information management means both manage a writing start number and a reading end number for use in writing/reading data into a storage device respectively. Applicants have repeatedly pointed out how the single citation to col. 14, lines 48-51 of Wolff fails to teach or suggest these clearly recited features of the present invention, but the Examiner has never answered these arguments (the mere assertion in the Advisory Action “that this limitation [from claim 1] is broadly interpreted as reading on the cited portion of Wolff” is a conclusory opinion statement that does not address Applicants’ detailed arguments). Merely adding a secondary reference to the previous rejection does not relieve the Examiner of his burden to answer Applicants’ either, when the secondary reference is cited only for other features of the claim, and not to resolve the deficiencies in the primary reference that were clearly pointed out on the record by Applicants.

The Examiner has clearly stated on the record that he considers Wolff’s Clients 54 and 56 analogous to the transmitter and receiver elements of the present invention (although the Examiner still has not stated on the record which of the Clients he deems analogous to which respective element of the present invention), and the two pointers described at col. 14, lines 48-55 analogous to the writing start number and the reading end number of the present invention. Even if such analogies were correct (which Applicants do not concede, as discussed further below), Wolff still fails to support the rejection as stated. The rejection fails to indicate anywhere where Wolff expressly teaches or suggests that both of the Clients 54 and 56 manage each of the pointers. The rejection is therefore deficient for at least these reasons.

The rejection is also deficient under Section 2143.03 because Wolff fails to teach or suggest how the Clients 54, 56 can be analogous to both of the transmitter and receiver elements of the present invention. Claim 1 of the present invention, for example, clearly features that both of the transmitter-side and receiver-side apparatuses include interface means for transmitting and receiving information with the other apparatus. Wolff, however, fails to teach or suggest any such direct interface between the Clients 54 and 56. In fact, Fig. 2A of Wolff, and its accompanying text, appear to teach the opposite.

Wolff clearly describes that the Clients 54-56 “are directly connected to storage volumes 64-66,” but not directly to each other for transmitting and receiving information apart from the storage volumes. A simple comparison of these portions from Wolff with Fig. 1 of the present invention illustrates the clear differences between the present invention and the prior art. Wolff’s Clients 54, 56 could thus only be reasonably interpreted to be both receivers, or both transmitters, but not one of each. Wolff’s two Clients function identically, and do not directly interface with one another.

The addition of Ikeda fails to resolve these clear deficiencies from Wolff. Although Ikeda does describe a transmitter and a receiver, Ikeda’s transmitter and receiver are not analogous to the Clients 54, 56 of Wolff. The transmission/reception in Ikeda is between the processor 1 and the communication system 2, and not directly between two processors 1, which would be the elements more analogous to Wolff. The two references cannot therefore be simply combined, as the rejection erroneously proposes. Wolff even teaches to remove its common server (60), whereas Ikeda requires a common network (2). Accordingly, the two prior art systems are inherently contradictory, and cannot be combined as proposed.

Even if the two references were not so inherently contradictory, the reference is still deficient on its face under the requirements of Section 2143.01 of the MPEP, as also previously argued. Section 2143.01 requires (absent any extrinsic evidence on the record) that the references themselves must provide some affirmative teaching or suggestion to combine the references as proposed. Such objective evidence must come from the references, and not merely from conclusory statements by the Examiner. In the present case, however, this requirement has not been met.

The only motivation expressed on the record for combining the references is the single, conclusory statement that “One would have been motivated to [combine Wolff with

The present invention is therefore unique with respect to both references, whether taken alone or together. The present invention features a transmitter and a receiver that can both communicate directly with each other, yet also both manage the start and end number of the storage device. Wolff fails to teach where its Clients communicate directly with one another, the cited portions of Ikeda describe only where the processor manages the read and write pointers (but not the network with which it communicates), and the rejection fails to cite to any teaching or suggestion from either reference for how two such different systems can be affirmatively modified to make up for the clear deficiencies in the other. Section 2143.01 requires that the references must also teach or suggest the objective motivation for any such modification. Accordingly, the present invention is not obvious over the two cited references, and the rejection should be withdrawn for still these further reasons.

For all of the foregoing reasons, Applicants submit that claim 1 of the present invention is in condition for allowance, and that this Panel with the outstanding obviousness rejection of claim 1 should be withdrawn.

Respectfully submitted,

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By



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May 14, 2007

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Ikeda] in order to ensure that all transfer requests are processed, thereby synchronizing of both write and read pointers.” Nothing from either reference though, nor particularly from Ikeda, teaches or suggests that combining the two references as proposed by the Examiner will “ensure that all transfer requests are processed.” The cited portion from Ikeda merely suggests the desirability of utilizing *Ikeda’s* own invention.

Section 2143.01, on the other hand, requires that the reference additionally teach or suggest the desirability of utilizing its own disclosure in combination with the base reference. The Examiner is not relieved of this requirement merely by stating that “the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” (Second to last line of the Advisory Action). Such “combined teachings” may only be appropriately combined in the first place when there is an affirmative teaching or suggestion within the references to make the combination. This requirement must be met before what the “combined teachings of the references would have suggested” may be considered. The rejection is therefore further deficient under Section 2143.01.

Lastly, even if the rejection were able to point to some teaching or suggestion from the references that indicates the proposed combination, the cited teachings from Ikeda do not actually read upon the features of the present invention for which it was cited. The present invention requires that both of the transmitter and receiver elements manage each of the writing start number and a reading end number. The cited text from col. 13 of Ikeda, however, merely describes how the single transfer control section 11 increments a read pointer and a write pointer. The control section 11 though, is shown to be only a portion of the processor 1 (see Fig. 6), and not the network 2, with which the processor transmits and receives data. The rejection fails to point to where Ikeda teaches that the network 2 itself can also manage both of the read and write pointers cited in col. 13.

Accordingly, it could not be obvious to combine Ikeda with Wolff for these additional reasons. The two systems are not analogous, and may not be combined and/or modified as proposed without removing critical portions of each respective system. It is not obvious to combine references when the proposed combination will render one or more of the references inoperable, or at least unusable for its intended purpose. In the present case, the proposed combination will at least require Wolff’s Clients to directly transmit/receive with each other and Ikeda to remove the central network 2.